

ESTTA Tracking number: **ESTTA373351**

Filing date: **10/14/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	GMA Accessories, Inc.		
Entity	Corporation	Citizenship	New York
Address	1 East 33rd Street New York, NY 10016 UNITED STATES		

Attorney information	Ashley J. Kumer The Bostany Law Firm 40 Wall Street 61st Floor New York, NY 10005 UNITED STATES mail@bozlaw.com Phone:2125304400
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### Applicant Information

Application No	77965616	Publication date	09/21/2010
Opposition Filing Date	10/14/2010	Opposition Period Ends	10/21/2010
Applicant	Dorfman-Pacific Co. 2615 Boeing Way Stockton, CA 95206 UNITED STATES		

### Goods/Services Affected by Opposition


Class 018. First Use: 2009/09/23 First Use In Commerce: 2009/09/23 All goods and services in the class are opposed, namely: Handbags; Tote bags
Class 025. First Use: 2009/09/23 First Use In Commerce: 2009/09/23 All goods and services in the class are opposed, namely: Hats

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Res Judicata effect of judgment against applicant's predecessor in cancellation proceeding 92044972. Applicant's failure to note GMA's prior ownership of CAPELLI in its application.

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3248875	Application Date	11/11/2006
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Registration Date	06/05/2007	Foreign Priority Date	NONE
Word Mark	CAPELLI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 1991/12/01 First Use In Commerce: 1991/12/18</p> <p>Bandanas; Bathrobes; Beach footwear; Beachwear; Belts; Berets; Blazers; Blouses; Body suits; Boots; Clothing, namely, knee warmers; Clothing, namely, wrap-arounds; Coats; Cravats; Ear muffs; Earbands; Embossed soles and heels of rubber or of plastic materials; Fabric belts; Fleece pullovers; Flip flops; Footwear; Foul weather gear; Fur cloaks; Fur coats and jackets; Fur jackets; Fur muffs; Galoshes; Gloves; Gowns; Hoods; Hosiery; Housecoats; Infant and toddler one piece clothing; Infant sleepers; Infants' shoes and boots; Infants' trousers; Infantwear; Jackets; Jerseys; Jogging pants; Knee-high stockings; Lace boots; Ladies' boots; Leather belts; Leather shoes; Leg shapers; Leg warmers; Leggings; Leotards; Light-reflecting jackets; Lingerie; Long sleeved vests; Loungewear; Men's socks; Mittens; Moccasins; Mufflers; Neck bands; Neck gaiters; Neckchiefs; Neckwear; Night gowns; Night shirts; Nightdresses; Nighties; Nightwear; One piece garment for infants and toddlers; Open-necked shirts; Pajamas; Parkas; Pullovers; Rain boots; Rain coats; Rain jackets; Rain suits; Rainproof jackets; Rainwear; Riding boots; Robes; Rubber shoes; Rubbers; Sashes; Scarves; Shawls; Shirts; Shoes; Short-sleeved shirts; Sleep shirts; Sleeping garments; Sleepwear; Sleeved or sleeveless jackets; Slippers; Socks and stockings; Suede jackets; Tank tops; Tights; V-neck sweaters; Vests; Wind coats; Wind resistant jackets; Women's shoes; Woollen socks; Wraps</p>		

U.S. Registration No.	3258734	Application Date	08/31/2006
Registration Date	07/03/2007	Foreign Priority Date	NONE
Word Mark	CAPELLI		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 003. First use: First Use: 1996/11/01 First Use In Commerce: 1997/01/31 Blush; Blush pencils; Body creams; Body emulsions; Body lotions; Body powder; Bubble bath; Cologne; Compacts containing make-up; Cotton for cosmetic purposes; Eau de cologne; Eau de perfume; Eau de toilette; Eye lotions; Eye make-up; Eye pencils; Eye shadows; Face and body creams; Face and body glitter; Facial cleansers; Facial creams; Facial make-up; Facial washes; False nails; Foam bath; Lip balm; Lip gloss; Lipstick; Lipstick cases; Lipstick holders; Make-up; Mouthwashes; Nail care preparations; Nail glitter; Nail polish; Perfumes; Skin creams; Skin lotions; Teeth cleaning lotions; Tooth cleaning preparations; Tooth polish; Toothpaste

U.S. Registration No.	3241182	Application Date	10/07/2006
Registration Date	05/15/2007	Foreign Priority Date	NONE
Word Mark	CAPELLI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1993/02/01 First Use In Commerce: 1993/04/22 Bracelets; Chokers; Clocks; Costume jewelry; Earrings; Gemstones; Gold and its alloys; Jewel chains; Jewelry; Jewelry chains; Jewelry for the head; Neck chains; Necklaces; Ornamental pins; Picture frames of precious metal; Precious gemstones; Rings being jewelry; Semi-precious gemstones; Silver and its alloys; Watches		

Related Proceedings	Cancellation Proceeding # 92044972
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Attachments	77041971#TMSN.jpeg ( 1 page )( bytes ) 78964585#TMSN.jpeg ( 1 page )( bytes ) 77016426#TMSN.jpeg ( 1 page )( bytes ) Notice.of.Opposition.10.14.10.pdf ( 5 pages )(167795 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/ AJK /
Name	Ashley J. Kumer

Date	10/14/2010
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

-----X  
GMA ACCESSORIES, INC.,

Opposer,

- against -

**NOTICE OF OPPOSITION**

DORFMAN-PACIFIC CO.,

Respondent.

-----X

Mark: CAPPELLI STRAWORLD

Serial No.: 77-965, 616

Class (es): 18, 25

Petitioner GMA Accessories, Inc. ("GMA"), through its undersigned counsel of record, hereby opposes the above application presented by DORFMAN-PACIFIC CO. ("DORFMAN-PACIFIC") to register CAPPELLI STRAWORLD in Classes 18 and 25 and in support thereof respectfully submits as follows:

1. GMA is the current title owner of Registration # 3,241,182 for the mark CAPELLI in International Class 14.
2. GMA is the current title owner of Registration # 3,241,184 for the mark CAPELLI in International Class 24.
3. GMA is the current title owner of Registration # 3,246,017 for the mark CAPELLI in International Class 9.
4. GMA is the current title owner of Registration # 3,248,875 for the mark CAPELLI in International Class 25.

5. GMA is the current title owner of Registration # 3,258,734 for the mark CAPELLI in International Class 3.
6. GMA is the current title owner of Registration #3,273,451 for the mark CAPELLI in International Class 28.
7. GMA is the current title owner of Registration #3,322,312 for the mark CAPELLI in International Class 26.
8. CAPPELLI STRAWORLD Mark consists of words only and prominently incorporates the word CAPPELLI which is practically identical to GMA's CAPELLI Mark.
9. DORFMAN-PACIFIC alleges use of its mark in connection with International Classes 18 and 25 as early as September 2009.
10. GMA's registration of CAPELLI in Class 25 shows use as early as 1991.
11. Bags are related to goods for which CAPELLI is registered to GMA.
12. GMA is the senior user.
13. GMA's registration in Class 25 pre-dates DORFMAN-PACIFIC's date of first use of CAPPELLI STRAWORLD.
14. The items with which the DORFMAN-PACIFIC commenced identifying with the mark CAPPELLI STRAWORLD are strikingly similar to those goods that were already being identified in commerce by GMA for many years before as CAPELLI.
15. In determining whether there is a likelihood of confusion, courts will consider whether the marks themselves are similar in appearance, sound, connotation and commercial impression. *In re. E. I. Dupont de Nemurs & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

16. Numerous courts have found a likelihood of confusion notwithstanding the inclusion of additional words, prefixes or suffixes. *In re Denisi*, 225 U.S.P.Q. 624 (TTAB 1985); *CFM Majestic, Inc. v. NHC, Inc.*, 93 F. Supp.2d 942 (N.D. Ind. 2000); *Trident Seafoods Corp. v. Triton Fisheries, LLC.*, 2000 WL 33675750 at \* 6 (D. Alaska June 30, 2000); 3 *McCarthy on Trademarks* §§ 23:55-23:56 at 23-164 through 23-169.

17. In determining whether there is a likelihood of confusion, the goods or services are to be compared to be determined if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

18. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565, 223 USPQ 1289 (Fed Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

19. The DORFMAN-PACIFIC Mark is similar to the GMA Mark in appearance, sound, connotation and commercial impression.

20. The goods that the DORFMAN-PACIFIC seeks to identify by its mark are commercially similar and will be marketed in similar commercial channels as GMA's services.

21. If the CAPPELLI STRAWORLD mark is allowed there will be likelihood of confusion with GMA's CAPELLI and dilution of GMA's CAPELLI mark.

22. DORFMAN-PACIFIC purchased CAPPELLI STRAWORLD, INC. sometime after 2006.

23. DORFMAN-PACIFIC is the successor in interest to CAPPELLI STRAWORLD, INC.

24. DORFMAN-PACIFIC is in privity with CAPPELLI STRAWORLD, INC.

25. Prior to filing its instant application, DORFMAN-PACIFIC had knowledge that GMA owned the mark CAPELLI.

26. GMA prevailed in a petition to cancel the CAPPELLI STRAWORLD Mark in 2006 in cancellation proceeding No. 92044972.

27. DORFMAN-PACIFIC's attorney, Charles Prescott represented CAPPELLI STRAWORLD, INC. in that proceeding.

28. On October 24, 2006, a Judgment was issued by the TTAB canceling the CAPPELLI STRAWORLD Mark.

29. DORFMAN-PACIFIC had a duty to include its awareness of GMA's CAPELLI Mark in its application.

30. DORFMAN-PACIFIC was aware its failure to disclose GMA's prior ownership of CAPELLI would decrease the chances of refusal.

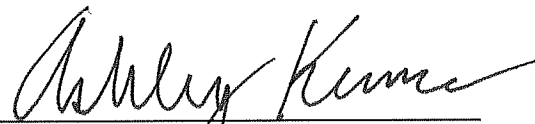
31. DORFMAN-PACIFIC's failure to disclose requires refusal of this application.

32. The TTAB's judgment canceling the CAPPELLI STRAWORLD' Mark is *res judicata* and requires refusal of this application.

WHEREFORE, GMA respectfully requests that the CAPPELLI STRAWORLD be refused registration.

Dated: October 14, 2010

Respectfully submitted,  
THE BOSTANY LAW FIRM

A handwritten signature in black ink, appearing to read 'Ashley Kurner', written over a horizontal line.

By: Ashley Kurner

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Attorneys for Opposer